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OFFICE OF PETITIONS

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In re Application of Zhou et al.	:	
Application No. 10/708,536	:	Decision Dismissing Petition
Filing Date: March 10, 2004	:	Under 37 CFR 1.78(a)(6)
Attorney Docket No. 10095/35	:	

This is a decision on the petition under 37 CFR 1.78(a)(6), filed July 16, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to a prior-filed provisional application. This also a decision on the petition under 37 CFR 1.182 requesting expedited consideration of the petition under 37 CFR 1.78.

The petition under 37 CFR 1.78(a)(6) is **dismissed**.

The petition under 37 CFR 1.182 is **granted**. The Office has expedited consideration of the petition under 37 CFR 1.78.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above. The amendment is not acceptable as drafted since it improperly incorporates by reference prior-filed provisional application no. 60/454,806.

The amendment adds the following statement to the beginning of the specification:

The present document claims the benefit of the filing date ... of U.S. Provisional Patent Application Serial No. 60/454,806, ... which is hereby incorporated by reference in its entirety.

An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment is not proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

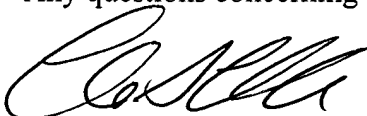
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